

REMARKS

The Office Action mailed June 8, 2004, has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Rejection(s) Under 35 U.S.C. § 112, First Paragraph

Claims 1 – 27 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The basis for these rejections is the recitation that the “object and concealed items transmit substantially no through x-rays” (Claim 1). Without conceding the propriety of the new matter-based rejections, and in the interest of expediting prosecution, Claims 1 – 27 have been amended to remove the offending language.

Rejection(s) Under 35 U.S.C. § 102 Rejection

Claims 1 – 3 and 14 – 17 were rejected under 35 U.S.C. § 102(b) as anticipated by Friddell (U.S. pat. no. 4,974,247).

Claims 1, 14 and 15, constituting all the independent claims, have been amended to state that detecting “includes differentiating x-rays backscattered by the object from x-rays backscattered by the Z material panel.” Support for this feature can be found in the written description and drawing figures. Specifically, FIGS. 5 and 6, depicting images generated in accordance with the invention, include regions 502 (FIG. 5) and 602 (FIG. 6), which are backscatter images attributable to Z material panels 500 and 600 respectively. Both regions 502

and 602 are lightly shaded and are differentiated from the unshaded region corresponding to the object 12.

In comparison, Friddell does not make a distinction between backscattering by the object 16 and the illuminator 32. In fact, Friddell relies on backscatter from both the object and the illuminator to produce the image, as is evident from for example the description in col. 7, lines 17 – 23, wherein it is stated that:

The detection means is operative to receive first backscattered (compton scattered and fluorescent radiation) radiation traveling in the second direction from illuminator 32 through object 16 at the inspecting location, and operative to receive second backscattered radiation interacting with object 16.

It will be appreciated that, according to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(b) only if each and every claim element is found, either expressly or inherently described, in a single prior art reference.¹ The aforementioned reasons clearly indicate the contrary, and withdrawal of the 35 U.S.C. § 102(b) rejection based on Friddell, which fails to show “differentiating x-rays backscattered by the object from x-rays backscattered by the Z material panel,” is respectfully urged.

Rejection(s) Under 35 U.S.C. § 103 Rejection

Claims 4 – 13 and 18 - 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over Friddell. However, Friddell fails to suggest the aforementioned missing claimed features. The rejection of Claims 4 – 13 and 18 - 27 under 35 U.S.C. § 103(a) based on Friddell is therefore improper and should be withdrawn.

¹ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).